

Attorney Docket No. P67040US0
Application No. 09/914,027

Remarks/Arguments:

Previously presented claims 2-4, with claims 3 and 4 amended hereby, are pending.

New claims 5 and 6 represent amended versions of claims 3 and 4, respectively. The amendment concerns the claim language "comprising reversed phase support material consisting of fatty acid residues containing hydroxy groups." On reviewing the claims, applicants became concerned that this language might be misinterpreted, i.e., in the sense that the fatty acid residues contain hydroxy groups. Therefore, claims 3 and 4 are amended by revising the language at issue to read "comprising reversed phase support material consisting of fatty acid residues and outer surfaces containing hydroxy groups."

According to the Office Action, claim 3 is withdrawn from prosecution as allegedly being directed to a different invention than provided in original claim 1 – which was replaced by claim 3. The refusal to examine claim 3 is improper and cannot be maintained.

Contrary to the Office Action, claim 1 is not merely "directed to a [sic] using a support material"; but, rather, claim 1 recites (*emphasis added*) "Use of a support material *for capillary electrochromatography*." Accordingly, the Office Action mistakenly states:

The Applicant has turned claim 1 into a claim that does [*not?*] correspond to the original claim. Claim 1 is directed to using a support material as claimed, and claim 3 is directed to a capillary electrochromatography method.

As explained above, both claim 1 and claim 3 are directed to "capillary electrochromatography," statements to the contrary in the Office Action, notwithstanding.

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Furthermore, and with all due respect, refusal to examine claim 3 is irreconcilable with the rejections under section 112, second paragraph, and section 101 set forth in the previous Office Action. According to the previous Office Action, claim 1 allegedly is indefinite and non-statutory. According to the rejection under section 112, second paragraph, "A claim is indefinite where it merely recites a use without any *active*, positive steps delimiting how this use is actually practiced" (*emphasis added*).

Claim 3 (rewritten claim 1) was submitted to overcome the §112, ¶2, rejection – i.e., by reciting *active*, positive steps. Now, after requiring that applicants amend claim 1 to recite "active, positive steps," the present Office Action attempts to justify refusal to examine claim 1 so amended – as present claim 3 – because it "positively recites process steps in the *active* tense" (*emphasis added*). The PTO cannot require applicants to amend a claim (to overcome a rejection) and, then, when the applicant amends the claim as required, refuse to examine the claim for being so amended. Such action is unfair, as well improper.

Accordingly, for the foregoing reasons, reinstatement and examination of claim 3 appears to be in order.

Claims 2 and 4 were rejected for alleged obviousness-type double patenting over claim 1 of US 6,074,555 (Boos). Reconsideration is requested.

According to the statement of rejection (Office Action, page 3):

The instant claims are different from claim 1 of US 6,074,555 in that they specify that the reversed phase material is limited to the pores of the particles. However, it would have been obvious to one of ordinary skill in the art that the inner surface of a porous article would necessarily be the surface of the pores of that particle.

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Contrary to the statement of rejection, Boos claim 1 does not recite – i.e., is not limited to – a "capillary," which is "filled with [the] support material," as in the present rejected claims. Since a limitation on the rejected claims – the *capillary* that is *filled* with the recited *porous support material* – is neither recited in Boos claim 1 nor shown to be an obvious variation of the subject matter recited in Boos claim 1, the statement of rejection fails to show that the presently claimed *capillary filled with a support material* represents an obvious variant of the "porous article support" subject matter of Boos claim 1. Domination alone does not support a double patenting rejection. *In re Kaplan*, 229 USPQ 678 (CAFC 1986). Therefore, withdrawal of the rejection for alleged obviousness-type double patenting appears to be in order.

Moreover, whether "it would have been obvious to one of ordinary skill in the art that the inner surface of a porous article would necessarily be the surface of the pores of that particle," as alleged in the statement of rejection, is irrelevant to a rejection for obviousness-type double patenting.

As held in *General Foods Corp. v. Studiengesellschaft Kohle m.b.H.*, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992) (*emphasis in original*):

Our precedent makes clear that the *disclosure* of a patent in support of a double patenting rejection cannot be used as though it were prior art, *even where the disclosure* is found in the claims

[P]atent claims are looked to only to see what *has been patented*, the subject matter which *has been patented*, not for something one may find to be disclosed by reading them. *In re Aldrich*, 398F.2d 855, 854, 1580 U.S.P.Q. 311, 314 (CCPA 1968).

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The rejection uses claim 1 of Boos as if it were a *prior art disclosure* over one skilled in the art would have allegedly found obvious the invention of present claims 2 and 4. However, "the *disclosure* of a patent in support of a double patenting rejection cannot be used as though it were prior art, *even where the disclosure* is found in the claims." 23 USPQ2d at 1846 (*emphasis in original*). The rejection was made in error because the PTO failed "to only to see what *has been patented*" by the limitations recited in the Boos' claim 1 and, instead, erroneously looked "for something one may find to be disclosed by reading them." 23 USPQ2d at 1846 (*emphasis in original*). Since the rejection failed to apply the correct standard for determining obviousness-type double patenting, the rejection is, further, in order to be withdrawn.

Claims 2 and 4 were rejected under 35 USC 102(e) as allegedly anticipated by Boos. Reconsideration is requested.

For anticipation under § 102 to exist, each and every claim limitation, as arranged in the claim, must be found in a single prior art reference. *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 225 USPQ 253 (Fed. Cir. 1985). The absence from a prior art reference of a single claim limitation negates anticipation. *Kolster Speedsteel A B v. Crucible Inc.*, 230 USPQ 81 (Fed. Cir. 1986). A reference that discloses "substantially the same invention" is not an anticipation. *Jamesbury Corp.* To anticipate the claim, each claim limitation must "*identically appear*" in the reference disclosure. *Gechter v. Davidson*, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997) (*emphasis added*). To be novelty defeating, a reference must put the public in possession of the identical invention claimed. *In re Donahue*, 226 USPQ 619 (Fed. Cir. 1985). A patent's claims are no

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measure of what a patent discloses for prior art purposes. *In re Benno*, 226 USPQ 683 (Fed. Cir. 1985).

According to the statement of rejection (Office Action, page 4), Boos anticipates the rejected claims because the reference allegedly

discloses an internal surface reverse phase packing material for chromatography, comprising a porous particle support having an outer surface and an inner reversed-phase surface, wherein fatty acid residues are attached through an ester bond between a fatty acid and an aliphatic hydroxyl group to form an inner reverse-phase surface (claim 1).

Regardless of whether the foregoing alleged disclosure is, in fact, found in Boos, this alleged disclosure fails to meet each and every claim limitation, as arranged in the rejected claims, as is necessary to show that anticipation exists. *Jamesbury Corp., supra*.

As explained, above, a "capillary" – which is "filled with support material" – is an indispensable limitation on each of rejected claims 2 and 4. The statement of rejection does not even allege that Boos meets this "capillary" limitation on the rejected claims. Moreover, the cited reference does not appear to teach, or even suggest, the "capillary" limitation – the word "capillary" certainly does not appear anywhere in Boos. Since a single limitation on the rejected claims is absent for Boos, anticipation based on Boos is negated. *Kolster Speedsteel A B, supra*, and, accordingly, withdrawal of the rejection of claims 2 and 4 based on Boos appears to be in order.

***Repeated Request for Acknowledgment of
Foreign Priority Under 35 USC 119***

A claim to foreign priority under 35 USC 119 has been made (inventorship declaration, filed January 8, 2002) and the certified copy of the priority document received by the PTO (Notification

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of Missing Requirements, mailed October 19, 2001, by the PTO, and Form PCT/IB304, mailed June 27, 2000, by the International Bureau).

Applicants have already once filed a "Request for Acknowledgment of Foreign Priority Under 35 USC 119" (April 27, 2004). The requested acknowledgment has yet to be made.

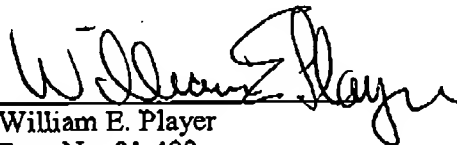
Accordingly, repeated request is made that the Examiner mark the next Office Action to acknowledge, both, the claim to §119 priority and receipt of the certified copy.

Favorable action is requested.

Respectfully submitted,

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